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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,966	11/07/2001	Ignacio Sanz-Pastor	22503-05565	3416

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LASTRA, DANIEL	
ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/007,966	SANZ-PASTOR ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-27,30-36 and 65-85* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-27,30-36 and 65-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 22-27, 30-36 and 65-85 have been examined. Application 10/007,966 (INTERACTIVE ADVERTISING WITH AN AUTOMATED VIEWING REWARD SYSTEM) has a filing date 11/07/2001 and Claims Priority from Provisional Application 60247473 (11/08/2000).

Response to Amendment

2. In response to Non Final Rejection filed 03/07/2008, the Applicant filed an Amendment on 09/08/2008, which amended claim 22, cancel claims 1-21, 28-29 and 37-64 and added new claims 65-85.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 65-84 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory

requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 65-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims recite "responsive to the first or second amount of time exceeding a threshold amount of time associated with the advertisement, awarding value to the viewer". Nowhere, in Applicant's specification said limitation is recited or described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 65-85 recite "responsive to the first or second amount of time exceeding a threshold amount of time associated with the advertisement, awarding value to the viewer". For purpose of art rejection said limitation

would be interpreted as awarding a user for the amount of time of viewing an advertisement, when said time of viewing is greater than a preselected period.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-27, 30-36 and 65-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLuca (US 5,870,030) in view of Jacobs (US 2001/0044741).

Claim 22 DeLuca teaches:

A system for providing interactive advertising comprising:

A content server for providing programming content and advertisements to a user (see col 7, lines 40-67), each advertisement having an associated value and displayed automatically to the user (see col 1, lines 35-50; col 8, lines 5-20);

permitting the user to select which of the advertisements are to be played (see col 11, lines 3-25); and awarding the associated value to the user for each of the advertisements that are played (see col 8, lines 6-40).

DeLuca does not teach providing video programming content and advertisements. However, Jacobs teaches that it is old and well known in the promotion art to display programming video content and advertisements to users where said advertisement content is used to subsidize the displaying of said video content (see paragraph 32 and 160-161). Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the application was made, to know that the DeLuca's system of paying users for viewing ads with content where said ads have a preselected value would be applied to video content, as Jacobs teaches that it is old and well known in the promotion art to subsidize the cost of viewing video programming content by watching video advertisements.

Claim 23 DeLuca teaches:

wherein providing programming to a user comprises: providing the programming in response to a request from the user for the content contained in the programming (see col 9, lines 20-30).

Claim 24 DeLuca teaches:

wherein providing programming to a user comprises: transmitting the content to the user via a computer network (see col 7, lines 60-67).

Claim 25, and 26 , DeLuca does not teach:

providing programming to a user comprises:

combining the content and the advertisements into a single programming stream, the single programming stream including blocks of content separated by blocks of advertisements, and providing the single programming stream to the user; each block of advertisements being associated with a monetary amount and the value awarded to the user including the monetary amounts associated with the blocks of advertisements that are played. However, Jacobs teaches providing content and advertisements to users where the cost of viewing said content is subsidized by the viewing of said advertisements (see paragraphs 160-161). Therefore, it would have been obvious to a

person of ordinary skill in the art at the time the application was made, to know to DeLuca concept of crediting users for viewing ads would be implemented in the Jacobs' system as the Jacobs system is equally applicable to portable devices receiving stock quotations via a wireless network (see Jacob paragraph 60).

Claim 27 DeLuca teaches:

advertisements are associated with credit amounts usable against fees paid by the user for the content (see paragraphs 64-65); and

the value awarded to the user includes the credit amounts associated with the advertisements that are played (see paragraph 161).

Claim 30 DeLuca does not expressly teach:

wherein permitting the user to select which of the advertisements are to be played comprises: permitting the user to define criteria for selecting which of the advertisements are to be played, wherein an advertisement is played or skipped according to the defined criteria. However, Jacobs teaches in paragraph 12; figure 5B; paragraph 76 allowing users to "customize or modified the ads you see", allows users to hide ads from view"; paragraph 160 "the user may deletes ads or play lists (or both) from, for example, his/her computer on a random or periodic basis". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know to DeLuca concept of crediting users for viewing ads would be implemented in the Jacobs' system as the Jacobs system is equally applicable to portable devices receiving stock quotations via a wireless network (see Jacob paragraph 60).

Claim 31 DeLuca teaches:

wherein the value awarded to the user depends on the manner in which the advertisements are played (see col 11, lines 20-25).

Claim 32 and 36, DeLuca fails to teach:

the value awarded to the user depends on a relationship between the advertisements played and the statistics collected. However, Jacobs teaches a system that award value to a user based upon said user's playlist (see paragraph 65, 130-131 "playlist request information"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know to DeLuca concept of crediting users for viewing ads would be implemented in the Jacobs' system as the Jacobs system is equally applicable to portable devices receiving stock quotations via a wireless network (see Jacob paragraph 60).

Claim 33 DeLuca fails to teach:

targeting the advertisements provided to the user based on the statistics collected for the user. However, Jacobs teaches targeting ads to users based upon statistics collected for the user (see paragraph 130-131; 142). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to users based upon statistics collected from said users, as Jacobs teaches that it is old and well known to do so.

Claim 34 DeLuca fails to teach:

clustering the user into a group of users according to the statistics collected for the user and targeting the advertisements provided to the user based on the group into

which the user is clustered. However, Jacobs teaches targeting ads to users based upon statistics collected for the user (see paragraph 130-131; 142, 171). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to users based upon statistics collected from said users, as Jacobs teaches that it is old and well known to do so.

Claim 35, DeLuca fails to teach:

clustering the user into a demographic group according to the statistics collected for the user and targeting the advertisements provided to the user based on the demographic group into which the user is clustered. However, Jacobs teaches targeting ads to users based upon statistics collected for the user (see paragraph 130-131; 142, 171). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to users based upon statistics collected from said users, as Jacobs teaches that it is old and well known to do so.

Claims 65 and 85, DeLuca teaches:

A method for providing interactive advertising comprising: receiving video programming content and advertisements; displaying to a viewer at least a portion of the received video programming content;

automatically displaying to the viewer at least one of the received advertisements in addition to the displayed programming content (see col 11, lines 5-15);

receiving after a first amount of time a request from the viewer to stop displaying the displayed advertisement (see col 8, lines 30-35 "action by the user");

responsive to the received request, stopping the display of the advertisement (see col 8, lines 30-35); and

responsive to the first amount of time exceeding a threshold amount of time associated with the advertisement, awarding value to the viewer (see col 11, lines 15-25).

DeLuca does not teach providing video programming content and advertisements. However, Jacobs teaches that it is old and well known in the promotion art to display programming video content and advertisements to users where said advertisement content is used to subsidize the displaying of said video content (see paragraph 32 and 160-161). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the DeLuca's system of paying users for viewing ads with content where said ads have a preselected value would be applied to video content, as Jacobs teaches that it is old and well known in the promotion art to subsidize the cost of viewing video programming content by watching video advertisements.

Claim 66, DeLuca teaches:

wherein the received video programming has an associated cost to the viewer, and awarding value to the viewer further comprises crediting the viewer for at least a portion of the cost (see col 11, lines 15-25).

Claim 67, DeLuca teaches:

automatically displaying to the viewer for a second amount of time a second advertisement in addition to the displayed programming content and the first advertisement (see col 11, lines 1-25);

responsive to the second amount of time exceeding a threshold amount of time associated with the second advertisement, awarding value to the viewer (see col 11, lines 1-25). DeLuca does not teach a video programming content. However, the same rejection applied to claim 65 regarding this missing limitation is also applied to claim 67.

Claim 68, DeLuca does not teach:

wherein the second advertisement is targeted to the viewer according to the viewer's usage history. However, Official Notice is taken that it is old and well known in the promotion art to target ads to users based upon viewing history. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to user based upon said user's viewing history as it is old and well known to do so.

Claim 69, DeLuca does not teach:

wherein the viewer's usage history includes data describing which advertisements have previously been skipped by the viewer. However, Official Notice is taken that it is old and well known in the promotion art to monitor the ads viewed by users in order to target ads to said users. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to user based upon said user's viewing history as it is old and well known to do so.

Claim 70, DeLuca does not teach:

wherein the second advertisement is targeted to the viewer according to the viewer's demographics. However, Jacobs teaches that it is old and well known in the promotion art to target ads based upon viewer's demographics (see paragraph 171). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would target ads to user based upon said user's demographics as it is old and well known to do so.

Claim 71, DeLuca teaches:

receiving a request from the viewer to stop the display of the second advertisement; and responsive to receiving the request, stopping the display of the second advertisement (see col 8, lines 30-37).

Claim 72, DeLuca teaches:

wherein each advertisement has an associated value, and awarding value to the viewer includes awarding the value associated with each advertisement displayed to the viewer for at least an associated threshold amount of time (see col 11, lines 5-25).

Claim 73, DeLuca teaches:

wherein the received programming content is displayed to the viewer in response to a request from the viewer for the content (see col 11, lines 5-25). DeLuca does not teach video programming content. However, the same rejection made in claim 65 regarding this missing limitation is also made in claim 73.

Claim 74, DeLuca does not teach:

wherein receiving video programming content further comprises receiving a video stream over a network. However, Jacobs teaches that it is old and well known in the promotion art to receive video stream over a network (see paragraph 32). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would transmit video content over a network, as it is old and well known to do so, as taught by Jacobs.

Claim 75, Jacobs does not teach:

wherein receiving video programming content further comprises receiving a physical medium including the content. However, Jacobs teaches that it is old and well known in the promotion art to provide CDRoms to users containing content (see paragraph 32). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would transmit video content over a physical medium, as it is old and well known to do so, as taught by Jacobs.

Claim 76, DeLuca teaches:

wherein receiving advertisements further comprises receiving advertisements over a network (see figure 1).

Claim 77, DeLuca teaches:

wherein the value awarded to the viewer depends at least in part on the time of day at which the advertisement is displayed (see col 11, lines 15-25).

Claim 78, DeLuca teaches:

A method for providing interactive advertising comprising:

receiving programming content and advertisements (see col 11, lines 15-25);

displaying to a viewer at least a portion of the received programming content (see col 11, lines 15-25);

automatically displaying to the viewer at least one of the received advertisements in addition to the displayed programming content (see col 11, lines 15-25); and

responsive to the advertisement being displayed for at least a first threshold amount of time, awarding value to the viewer (see col 11, lines 15-25).

DeLuca does not teach providing video programming content and advertisements. However, Jacobs teaches that it is old and well known in the promotion art to display programming video content and advertisements to users where said advertisement content is used to subsidize the displaying of said video content (see paragraph 32 and 160-161). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the DeLuca's system of paying users for viewing ads with content where said ads have a preselected value would be applied to video content, as Jacobs teaches that it is old and well known in the promotion art to subsidize the cost of viewing video programming content by watching video advertisements.

Claim 79, DeLuca teaches:

wherein the received programming has an associated cost to the viewer, and awarding value to the viewer further comprises crediting the viewer for at least a portion of the cost (see col 11, lines 15-25). DeLuca does not teach video programming.

However, the same rejection applied to claim 78 regarding this missing limitation is also applied to claim 79.

Claim 80, DeLuca teaches:

automatically displaying to the viewer a second advertisement; responsive to the second advertisement being displayed for at least a second threshold amount of time, awarding value to the viewer (see col 11, lines 15-25).

Claim 81, DeLuca teaches:

wherein the first threshold amount of time is determined according to the advertisement displayed (see col 11, lines 15-25).

Claim 82, DeLuca does not teach:

wherein receiving video programming content further comprises receiving a video stream over a network. However, Jacobs teaches that it is old and well known in the promotion art to receive video stream over a network (see paragraph 32). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that DeLuca would transmit video content over a network, as it is old and well known to do so, as taught by Jacobs.

Claim 83, DeLuca does not teach:

wherein receiving video programming content further comprises receiving a physical medium including the content. However, Jacobs teaches that it is old and well known in the promotion art to provide CDRoms to users containing content (see paragraph 32). It would have been obvious to a person of ordinary skill in the art at the

time the application was made, to know that DeLuca would transmit video content over a physical medium, as it is old and well known to do so, as taught by Jacobs.

Claim 84, DeLuca teaches:

wherein receiving advertisements further comprises receiving advertisements over a network (see figure 1).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The Applicant argues that DeLuca does not teach each advertisement is displayed automatically to the user. The Examiner answers that DeLuca teaches displaying ads to user in a ad list (see col 11, lines 1-15) and that it is old and well known in the promotion art to display ads with content (see col 1, lines 35-50). Therefore, contrary to Applicant's argument, DeLuca teaches Applicant's claimed invention.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Examiner, Art Unit 3688
December 8, 2008